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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,987	11/21/2001	Risto Kivipuro	460-010723-US(PAR)	3443

2512 7590 04/28/2009

PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06824

EXAMINER	
WINTER, JOHN M	
ART UNIT	PAPER NUMBER
3685	

MAIL DATE	DELIVERY MODE
04/28/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/990,987	KIVIPURO ET AL.	
	Examiner	Art Unit	
	JOHN M. WINTER	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 February 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-14,16-25 and 33-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-14,16-25 and 33-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

Applicants' amendment filed on July 22, 2008 is hereby acknowledged.

Accordingly, claims 2-14, 16-25 and 33-45 remain pending.

Response to Arguments

1. The Applicants arguments filed on July 22, 2008 have been fully considered.

The Applicants amended claims are rejected in view of newly discovered reference Sherer et al. (US Patent 5,459,854).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 35-42 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

3. In this particular case, claim 35 fails prong (1) because the method steps are not tied to a machine and can be performed without the use of a particular machine. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

4. Claims 36-42 are dependant upon claim 35 and rejected for at least the same reason.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 46-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of the server as claimed is not limited by the software features (e.g. compiler, selector etc..) as disclosed in the claim.

6. Claims 47 and 48 are dependant upon claim 46 and are rejected for at least the same reasons.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 2-14, 16-25 and 33-48 are rejected under 35 U.S.C. §103 as being unpatentable over Kaydyk et al (6,209,111) in view of either Ginter et al (U.S. 5,892,900) or Watanabe et al (U.S. 6,084,888) and further in view of Sherer et al. (US Patent 5,459,854).

9. Regarding claim 35,

Kaydyk et al (See Figs. 7 and 11, Col. 1, lines 45-65, Col. 9, lines 50-65,) disclose a method for associating content with a data structure (header) in a wireless communication device substantially as claimed. The differences between the above and the claimed invention is the use of explicit data structure definition. It is noted that the claim appears to read on all wireless packets with headers. It is further noted that metadata describes or defines other data and is normally present as a constituent of complex header data. Each of Ginter et al (See Figs 5b, 17, 20, 26-30, Col. 284, lines 15- 40) or Watanabe et al (See Fig. 5-7, 11-12 and claims 1-11) show packets with complex headers in a wireless environment including metadata. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Kaydyk et al because packet

headers are conventional functional equivalents of the claim limitations; furthermore the combination of these elements does not alter their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

10. Kaydyk et al does not explicitly disclose examining a property of a wireless communication device; selecting a device-specific content component from a set of different versions of device-specific content components to be loaded in a device specific content packet to the wireless communication device; Sherer et al. ('854) discloses examining a property of a wireless communication device; selecting a device-specific content component from a set of different versions of device-specific content components to be loaded in a device specific content packet to the wireless communication device; (Column 5, lines 32-65 --- Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

11.). It would be obvious to one having ordinary skill in the art at the time of the invention to combine Kaydyk et al method with Sherer et al.'s teaching in order to allow the consumer download authenticated copies of electronic media.

12. Regarding the data limitations of claim 2, Ginter et al (See Figs 5b, 17, 20, 26-30) or watanabe et al (see Fig. 5-7, 11-12 and claims 1-11) show packets with complex headers in a wireless environment that are conventional functional equivalents of the claim limitations.
13. Official Notice is taken that "a device specific content packet" is common and well known in prior art in reference to network protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a device specific content packet in order to authenticate the client device. The Examiner notes that this feature is commonly used by any system utilizing a network with a digitally signed, commonly used in secure networks and content distribution systems. See *e.g.* Yianolos.
14. Xlaims 35, 36, 43 and 44 are in parallel with claim 35 and are rejected for at least the same reasons.
15. Regarding server limitations of claim 3, Kaydyk et al (See elements 12 or 16) disclose web server equivalents that are conventional functional equivalent of the claim limitations.
16. Regarding storage limitations of claim 4, Kaydyk et al (See elements 59 and 61) disclose storage that is conventional functional equivalent of the claim limitations.
17. Regarding the separate storage limitations of claim 5, Kaydyk et al (See Figs. 7 and 11, Col. 1, lines 45-65, Col. 9, lines 50-65,) disclose a method for associating content with a separate data structure (header) in a wireless communication device that are conventional functional equivalents of the claim limitations.

18. Regarding definition limitations of claim 6, Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that is conventional functional equivalent of the claim limitations.
19. Regarding charge limitations of claim 7, Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that includes usage charge that is conventional functional equivalent of the claim limitations.
20. Regarding protection limitations of claim 8, Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that includes copy protection that is conventional functional equivalent of the claim limitations.
21. Regarding the encryption limitations of claim 9, Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that includes encryption that are conventional functional equivalents of the claim limitations.
22. Regarding content limitations of claim 10, Ginter et al (See Figs 5b, 17, 20, 26- 30) show multimedia content definition within a complex packet header that is conventional functional equivalent of the claim limitations.
23. Regarding executable limitations of claim 11, Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet-header that includes executable code that is conventional functional equivalent of the claim limitations.
24. Regarding storage limitations of claim 12, Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that includes storage definition that is conventional functional equivalent of the claim limitations.

25. Regarding classification limitations of claim 13 Ginter et. al. (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that includes multimedia data classified by type that is conventional functional equivalent of the claim limitations.
26. Regarding information limitations of claim 14, Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that includes new data that is conventional functional equivalent of the claim limitations.
27. Regarding the data limitations of claim 16, Ginter et al (See Figs 5b, 17, 20, 26- 30) or Watanabe et al (See Fig. 5-7, 11-12 and claims 1-11) show packets with complex headers in a wireless environment that are conventional functional equivalents of the claim limitations.
28. Regarding server limitations of claim 17, Kaydyk et al (See elements 12 or 16) disclose web server equivalents that are conventional functional equivalent of the claim limitations.
29. Regarding the separate storage limitations of claim 18, Kaydyk et al (See Figs. 7 and 11, Col. i, lines 45-65, Col. 9, lines 50- 65,) disclose a method for associating content with a separate data structure (header) in a wireless communication device that are conventional functional equivalents of the claim limitations.
30. Regarding version limitations of claim 19, Ginter et al (See Figs 5b, 17, 20, 26-30) show different content definition within a complex packet header that is conventional functional equivalent of the claim limitations.

31. Regarding definition limitations of claim 20, Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that is conventional functional equivalent of the claim limitations.
32. Regarding charge limitations of claim 21, Ginter et al (See Figs 5b, 17, 20, 26- 30) show content definition within a complex packet header that includes usage charge that is conventional functional equivalent of the claim limitations.
33. Regarding protection limitations of claim 22, Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that includes copy protection that is conventional functional equivalent of the claim limitations.
34. Regarding the encryption limitations of claim 23, Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that includes encryption that are conventional functional equivalents of the claim limitations.
35. Regarding classification limitations of claim 24 Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that includes multimedia data classified by type that is conventional functional equivalent of the claim limitations.
36. Regarding searching limitations of claim 25, Ginter et al (See Figs 5b, 17, 20, 26-30) show content definition within a complex packet header that includes pointers that is conventional functional equivalent of the claim limitations.
37. Regarding claim 33, Kaydyk et al (See Figs. 7 and ii, Col. i, lines 45-65, Col. 9, lines 50-65,) disclose a method for associating content with a data structure (header) in a wireless communication device substantially as claimed. The differences between the above and the claimed invention is the use of explicit data structure definition. It is noted that the

claim appears to read on all wireless packets with headers. It is further noted that metadata describes or defines other data and is normally present as a constituent of complex header data. Each of Ginter et al (See Figs 5b, 17, 20, 26-30, Col. 284, lines 15-40) or Watanabe et al (See Fig. 5-7, 11-12 and claims 1-11) show packets with complex headers in a wireless environment including metadata and storage. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Kaydyk et al because packet headers are conventional functional equivalents of the claim limitations.

Official Notice is taken that "examining the data structure of the content packet to identify download properties of the content packet and compatibility of the at least one content component with the wireless device; selectinq at least one content component which said examining indicated is compatible with the wireless device;" is common and well known in prior art in reference to network protocols (Examiner notes that the term "data structure" is construed as including a digital certificate). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a device specific content packet in order to authenticate the client device. The Examiner notes that this feature is commonly used by any system utilizing a network with a digitally signed packets, commonly used in secure networks and content distribution systems. See *e.g.* Yianolos for a typical implementation. – Examiner notes that the system described is tied to a unique system implementation by the use of a specific key.

38. Examiner notes that the language "to identify download properties of the device specific content packet and compatibility of the at least one device specific content component with the particular wireless device; selecting at least one device specific content component which said examining indicated is compatible with the particular wireless device; "is representative of non-functional descriptive information and it has been held such information will not distinguish a claimed device from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01).

39. Regarding selection limitations of claim 36, Ginter et al (See Figs 5b, 17, 20, 26-30, Col. 284, lines 15-40) show content definition within a complex packet header that includes metadata and multimedia data classified by type that is conventional functional equivalent of the claim limitations.
40. Regarding content limitations of claims 37-42, Ginter et al (See Figs 5b, 17, 20, 26-30, Col. 284, lines 15-40) show content definition within a complex packet header that includes metadata, content descriptors, and multimedia data classified by type that is conventional functional equivalent of the claim limitations.
41. Regarding claim 43, Kaydyk et al (See Figs. 7 and 11, Col. 1, lines 45-65, Col. 9, lines 50-65,) disclose a means for associating content with a data structure (header) in a wireless communication device substantially as claimed. The differences between the above and the claimed invention is the use of explicit data structure definition. It is noted that the claim appears to read on all wireless packets with headers. It is further noted that

metadata describes or defines other data and is normally present as a constituent of complex header data. Each of Ginter et al (See Figs 5b, 17, 20, 26-30, Col. 284, lines 15-40) or Watanabe et al (See Fig. 5-7, 11-12 and claims i-ii) show packets with complex headers in a wireless environment including metadata. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Kaydyk et al because packet headers are conventional functional equivalents of the claim limitations.

42. Regarding claim 44, Ginter et al (See Figs 5b, 17, 20, 26-30, Col. 284, lines 15-40) show content definition within a complex packet header that includes metadata and multimedia data classified by type that is conventional functional equivalent of the claim limitations.
43. Regarding claim 45, Ginter et al (See Abstract, Figs 5b, 17, 20, 26-30, Col. 284, lines 15-40) shows wherein each content component comprises a media presentation.

44. Claims 45-48 are not patentably distinct from the above rejected claims and are rejected for at leas the same reasons.
45. In regard to Claim 46 the features of information stored in memory are representative of non-functional descriptive information and it has been held such information will not distinguish a claimed device from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01).

Conclusion

46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

47. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

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